

REMARKS

Applicants request that the Patent Office acknowledge Applicants' claim to domestic priority to U.S. Provisional Application No. 60/227,852 as evidenced by paragraph [0001] of the specification of the U.S. Application No. 09/832,828 filed on April 12, 2001.

Claims 1-4, 7, 8, 10-23, 26-41 and 43-55 and 57 have been examined on their merits, and are all the claims presently pending in the application.

1. Claims 1-4, 7, 8, 11-17, 19-23, 26-29, 31-41, 43-45, 47-53, 55 and 57 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tso *et al.* (U.S. Patent No. 6,047,327) in view of Kaplan *et al.* (U.S. Patent No. 5,446,891). Applicants traverse the rejection of claims 1-4, 7, 8, 11-17, 19-23, 26-29, 31-41, 43-45, 47-53, 55 and 57 at least for the reasons discussed below.

The combination of Tso *et al.* and Kaplan *et al.* does not teach or suggest at least associating each data item with a generic action menu and an application specific menu that corresponds to an outside application that is executing on a data item computer, as recited in claim 1. The combination of Tso *et al.* and Kaplan *et al.* lacks any teaching or suggestion of at least the association of each data item with an application-specific action menu (*e.g.*, an exemplary application-specific action menu is shown in Figure 8 of the instant application) that corresponds to an application executing on a data item computer, or a generic action menu, or both. For example, the primary reference, Tso *et al.*, disclose data being pushed to a terminal, but the alleged application-specific action menu operates on the client (*i.e.*, client A (23) in

Figure 3 of Tso *et al.*). The action menus of Tso *et al.* (Figure 4 and col. 8, line 65 to col. 9, line 65) disclose action menus that operate on applications (e.g., Infocast browser) operating on the client, and not on an outside data item computer that is pushing data items to the subscriber according to a provisioning profile associated with the subscriber. Kaplan *et al.* lack any teaching or suggestion of at least the potential association of each data item with an application-specific action menu that corresponds to an outside application executing on a data item computer, or a generic action menu, or both. Moreover, there is no teaching or suggestion in the combination of Tso *et al.* and Kaplan *et al.* that the alleged application-specific menu is associated with an application operating on a content provider computer, e.g., a data item computer. For example, Tso *et al.* lack any teaching or suggestion that the Infocast browser interacts with the content provider computer beyond processing data items pushed to the Infocast browser. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Although the Patent Office claims that one of ordinary skill in the art would have been motivated to associate a data item (or items) with an application-specific action menu that corresponds to an outside application executing on a data item computer, both Tso *et al.* and Kaplan *et al.* lack any teaching or suggestion about such an association between data items, menus and outside applications executing on a data item computer. Thus, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that the combination of Tso *et al.* and

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Kaplan *et al.* fails to teach or suggest all of the claimed elements as arranged in claim 1.

Applicants submit that claim 1 is allowable, and further submit that claims 2-4, 7, 8 and 11-13 are allowable as well, at least by virtue of their dependency from claim 1. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 1-4, 7, 8 and 11-13.

Applicants submit that claim 14 is allowable for at least reasons analogous to those discussed for claim 1, in that combination of Tso *et al.* and Kaplan *et al.* fails to teach or suggest at least the associating each data item with an application specific menu that corresponds to an outside application executing on a data item computer, or a generic action menu, or both. Applicants further submit that claims 15-17 are allowable as well, at least by virtue of their dependency from claim 14. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 14-17.

Applicants submit that claim 19 is allowable for at least reasons analogous to those discussed for claim 1, in that combination of Tso *et al.* and Kaplan *et al.* fails to teach or suggest at least the associating each data item with an application specific menu that corresponds to an outside application executing on a data item computer, or a generic action menu, or both. Applicants further submit that claims 20-23, 26-29 and 31-33 are allowable as well, at least by virtue of their dependency from claim 19. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 19-23, 26-29 and 31-33.

Applicants submit that claim 34 is allowable for at least reasons analogous to those discussed for claim 1, in that combination of Tso *et al.* and Kaplan *et al.* fails to teach or suggest

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at least the associating each data item with an application specific menu that corresponds to an outside application executing on a data item computer, or a generic action menu, or both.

Applicants further submit that claims 35-41 and 43-45 are allowable as well, at least by virtue of their dependency from claim 34. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 34-41 and 43-45.

Applicants submit that claim 47 is allowable for at least reasons analogous to those discussed for claim 1, in that combination of Tso *et al.* and Kaplan *et al.* fails to teach or suggest at least the associating each data item with an application specific menu that corresponds to an outside application executing on a data item computer, or a generic action menu, or both. Applicants further submit that claims 48-53 are allowable as well, at least by virtue of their dependency from claim 47. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 47-53.

Applicants submit that claims 55 and 57 are allowable for at least reasons analogous to those discussed for claim 1, in that combination of Tso *et al.* and Kaplan *et al.* fails to teach or suggest at least the associating each data item with an application specific menu that corresponds to an outside application executing on a data item computer, or a generic action menu, or both. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 55 and 57.

2. Claims 10, 18, 30, 46 and 54 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tso *et al.* in view of Kaplan *et al.* and in further view of Gerace (U.S. Patent No. 5,848,396). Applicants traverse the rejection of claims 10, 18, 30, 46 and 54 at least for the reasons discussed below.

Claim 10 depends from claim 1, and includes all the recitations of claim 1 by virtue of its dependency. The combination of Tso *et al.*, Kaplan *et al.* and Gerace does not teach or suggest at least associating each data item with at least an application specific menu that corresponds to an outside application executing on a data item computer, or a generic action menu, or both, as recited in claim 1, and included in claim 10 via dependency. The deficiencies of the combination of Tso *et al.* and Kaplan *et al.* have been discussed above with respect to claim 1, and that discussion is incorporated here by reference. Gerace discloses, *inter alia*, a method of determining a behavioral profile of a computer user, but lacks any teaching or suggestion of at least potentially associating each data item with at least an application specific menu that corresponds to an outside application executing on a data item computer, or a generic action menu, or both, as recited in claim 1, and included in claim 10 via dependency. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Although the Patent Office claims that one of ordinary skill in the art would have been motivated to associate a data item (or items) with an application-specific action menu that corresponds to an outside application executing on a data item computer, Tso *et al.*, Kaplan *et al.* and Gerace all lack any teaching or suggestion about such an association between data items,

menus and outside applications executing on a data item computer. Thus, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that the combination of Tso *et al.*, Kaplan *et al.* and Gerace fails to teach or suggest all of the claimed elements as arranged in claim 1, and included via dependency in claim 10. Thus, Applicants submit that claim 10 is allowable, and respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claim 10.

Claim 18 depends from claim 14, and includes all the recitations of claim 14 by virtue of its dependency. Applicants submit that claim 18 is allowable for at least reasons analogous to those discussed for claim 10, in that combination of Tso *et al.*, Kaplan *et al.* and Gerace fails to teach or suggest associating each data item with a generic action menu or an application specific menu that corresponds to an outside application executing on a data item computer, or both types of menus. Thus, Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claim 18.

Claim 30 depends from claim 19, and includes all the recitations of claim 19 by virtue of its dependency. Applicants submit that claim 30 is allowable for at least reasons analogous to those discussed for claim 10, in that combination of Tso *et al.*, Kaplan *et al.* and Gerace fails to teach or suggest associating each data item with a generic action menu or an application specific menu that corresponds to an outside application executing on a data item computer, or both types

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of menus. Thus, Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claim 30.

Claim 46 depends from claim 34, and includes all the recitations of claim 34 by virtue of its dependency. Applicants submit that claim 46 is allowable for at least reasons analogous to those discussed for claim 10, in that combination of Tso *et al.*, Kaplan *et al.* and Gerace fails to teach or suggest associating each data item with a generic action menu or an application specific menu that corresponds to an outside application executing on a data item computer, or both types of menus. Thus, Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claim 46.

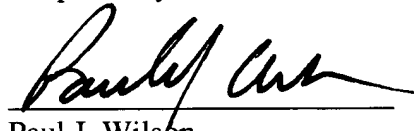
Claim 54 depends from claim 47, and includes all the recitations of claim 47 by virtue of its dependency. Applicants submit that claim 54 is allowable for at least reasons analogous to those discussed for claim 10, in that combination of Tso *et al.*, Kaplan *et al.* and Gerace fails to teach or suggest associating each data item with a generic action menu or an application specific menu that corresponds to an outside application executing on a data item computer, or both types of menus. Thus, Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claim 54.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Paul J. Wilson
Registration No. 45,879

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE:

23373

CUSTOMER NUMBER

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